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10/033,076	12/28/2001	Richard E. Smalley	11321-P012USD8	9985

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Ross Spencer Garsson  
Suite 800  
100 Congress Avenue  
Austin, TX 78701

EXAMINER

HENDRICKSON, STUART L

ART UNIT PAPER NUMBER

1754

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

101033016

Applicant(s)

Smalley

PTA

Examiner

Verbitsky

Group Art/Unit

1754

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 9/21/04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 91-98, 100-103, 163-182 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 91-98, 100-103, 163-182 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9/21/04
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 91, 93, 94-97, 100, 163-178 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Guo et al article, alone or in view of Wang article.

This is the same rejection previously made, incorporated herein by reference.

Claims 98, 101-103, 179-182 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guo et al., alone or in view of Wang, and taken with applicants' admissions in the specification and Fishbine.

The above does not teach the additional materials, however applicant indicates on specification pgs. 30, 27, 48, etc. that the coaxial cable, composites, etc. are old and known; applicant has a new filler. Fishbine indicates in the opening paragraphs that carbon nanotubes have particular properties and is taken to be representative of the known uses of nanotubes. The examiner takes Official Notice that the claimed structures of these dependent claims are old and known, nothing that there is nothing in the specification to indicate otherwise.

Using the nanotubes in a composite or manner claimed is an obvious expedient to exploit their emitter, conductive and other properties.

Applicant's arguments filed 9/2/04 have been fully considered but they are not persuasive.

The Wang reference provides reasonable evidence that the claimed number of fibers claimed is possessed. It should not be lost that the authors of the Guo reference include some of the instant inventors. Therefore, the assertion that Guo possesses the claimed number of fibers- even absent Wang- is reasonable. The recitation of dopant is a product limitation in a product claim. Therefore the argument that it refers to the intent in mind of the person who added it is not persuasive; it is not seen why the metal particle is not a dopant. In fact, claim 168 explicitly recites 'metals' and iron is in fact a 'metal'. On pg. 12-13 it is argued that the

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specification distinguishes over guo. However, this is not accepted as Guo is not mentioned by name. The use of different verbiage from the articles previously published by the applicants does not make the product different. The properties of the fibers versus those of guo have not been differentiated. As applicants indicate that the patentability resides in the fibers (inferred by the absence of an extended discussion of transmission cables in the specification), no patentability is seen in the compositions. Put another way, one of ordinary skill in the art knowing what applicants indicate to be the state of the transmission art would have found it obvious to modify known transmission systems with the fibers of Guo because doing so exploits the properties of the fibers. MWNTs and SWNTs do not have (emitter and electronic) properties so different that one does not suggest the other for transmission purposes, given what is known about SWNT and MWNT properties. Finally, claim 169-176 do not actually require anything beyond the fiber itself.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (571) 272-1351.



Stuart Hendrickson  
examiner Art Unit 1754